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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,124	07/12/2001	DuWayne C. Radke	56908US002	1697

32692 7590 03/09/2004

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EXAMINER
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GREEN, CHRISTY MARIE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/904,124

Applicant(s)

RADKE ET AL.

Examiner

Christy M Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Request for Continued Examination***

The request filed on 2/3/04 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on Application No. 09/904124 is acceptable and an RCE has been established. An action on the RCE follows. This is a first office action for the RCE filed for serial number 09/904124, entitled Pass-Through Fire Stop Device, originally filed on July 12, 2001.

### ***Response to Amendment***

In response to the examiner's advisory action Mailed December 29, 2003, the applicant cancelled claims 8 and 9 and added new claims 19-21. Newly submitted claim 21 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 1-20, drawn to a firestop device, classified in class 52, subclass 220.1.
- II. Claim 21, drawn to a method of creating a firestop opening in a concrete partition, classified in class 52, subclass 745.19.

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the firestop device of invention I does not necessarily have to be created in an opening of a concrete partition as stated in invention II, for example,

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the firestop device does not have to be secured to the form and then the concrete is poured, the concrete could be poured in section by section and then the device can be placed within the partition wall if a section of the form was created for the device to be placed after the concrete was poured.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 21 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Radke et al., U.S. Patent No. 6,694,684.

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,694,684. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claims a firestop device comprising a housing, firestop material arranged within the housing.

Claim 2-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Radke et al., U.S. Patent No. 6,694,684.

Claims 2-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,694,684. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claims a firestop device comprising a band including a pull tab that can allow a user to manually remove a band from the housing at a frangible portion; a base portion and a riser portion including a plurality of frangible connections.

Claim 18 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Radke et al., U.S. Patent No. 6,694,684.

Claim 18 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,694,684. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claims a firestop device comprising a housing, a base portion, and frangibly connected circumferential bands and a band including a pull tab that can allow a user to manually remove a band from the housing at a frangible portion.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 10 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munzenberger et al., US patent # 6,161,393 in view of Rodriguez, US Patent 5,588,267.

Munzenberger discloses the claimed invention including a firestop device (figure 2) comprising a housing (7), firestop material (11) arranged within the housing; the housing comprising a base portion (3) and a riser portion (7), the base portion including a recess (where 11 points to); the base portion includes a sidewall portion (where 3 points to) extending from a first open end (10) towards the riser portion (7), and a shoulder portion (2) extending inwardly from the sidewall portion to the riser portion (7); the sidewall (3) and shoulder (2) portions include inner surfaces having a rib (15); the housing has a first and second opposed open ends (10 and the opposite side of 10) and a hollow chamber (where 12 is located) having a longitudinal axis extending from the first open end to the second open end (figure 2); the first open end (10) is provided in the base portion (where 3 points to) and the second open end is provided in the riser portion (7), the firestop material (11) being provided in spaced relation (by 13) along the sidewall portion inner surface from the first open end to the shoulder portion (figure 2); the housing has a two-tiered cylindrical shape (figure 2) the base portion (3) having a

larger diameter than the riser portion (7); the base portion further includes a flange (4) adjacent the first open end (10); the riser portion (7) includes a plurality of equally segmented transverse bands (8) each including manually engageable pull tab (where 8 points to); a cap (9) attached to the riser portion (7); the cap contains snap connectors (see attached figure 2) that snap onto the riser portion; a retaining ring (4) arranged within the base portion first open end adjacent the firestop material.

Munzenberger does not disclose the housing including at least one frangible connection defining a removable band. Rodriguez teaches that it is known in the art to provide at least one frangible connection (20) defining a removable band (where 5 points to); and a pull tab (25) providing a grasping means (column 4, lines 28-34). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the frangible connection of the housing and the pull tab to grasp the band of Rodriguez with the housing of the firestop device of Munzenberger in order to provide different lengths of the housing for different sized walls (column 1, lines 35-37).

Claims 11-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Munzenberger in view of Rodriguez and further in view of Radke et al, US patent # 6,694,684.

In regards to claims 11-14, Munzenberger in view of Rodriguez discloses the claimed invention as stated above in claim 1, except for the pull tabs includes indicia indicating the length of the device and an extension member. Radke teaches that it is known in the art to provide the tabs with indicia (column 3, lines 59-62). It would have

been obvious to one having ordinary skill in the art at the time the invention was made to provide indicia on the pull tabs as taught by Radke in order to indicate the quantity of firestop material provided within the device (column 3, lines 59-62).

### ***Response to Arguments***

Applicant's arguments filed 2/3/04 have been fully considered but they are not persuasive.

In response to applicant's argument that Rodriguez is non-analogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, although Rodriguez reference pertains to a roof flashing, there is a housing (at 1) including the limitations of the applicants invention including teaching at least one frangible connection (20) defining a removable band (where 5 points to); and a pull tab (25) providing a grasping means (column 4, lines 28-34), and therefore is considered to be readable on the applicants invention.

In response to the applicants argument that there is no motivation to combine Rodriguez with Munzenberger, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.



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1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, firestop devices are well known within the art and the Rodriguez reference is fully capable of the recited limitations and use, the motivation for the rejection is found that by using the housing of Rodriguez, firestop material could be placed within the housing along the pipe (P) in order to slow down rate of fire from passing from one part of the housing to the next.

In regards to the Munzenberger reference number 15 is not a rib, and is a locking ring as cited within the Munzenberger reference at (column 4, lines 31-33), the examiner recognizes the argument, however, the examiner is interpreting the reference number 15 to be a rib, a rib is defined as something resembling a rib in shape or function, an elongated ridge. This definition is found within the Merriam Webster's Collegiate Dictionary, tenth edition and by this definition the examiner interprets Munzenbergers reference number 15 to be a rib.

### ***Conclusion***

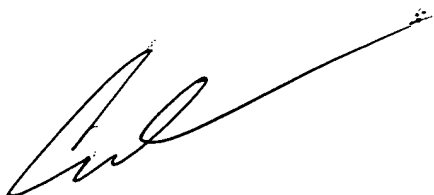
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christy M Green whose telephone number is 703-308-9693. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Eg

March 3, 2004



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